IFW AF/1617

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"Commissioner of Patents and Trademarks
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On August 12, 2004

Alan A. Bornstein 08/12/04
Alan A. Bornstein Date of Signature
Reg. No. 40,919
Attorney for Appellant(s)

PATENT

UNUS #: Y2-X380-GR
CASE #: J6638(C)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Customer No.: 000201
Appellants: Shana'a et al.
Serial No.: 09/930,320
Filed: August 15, 2001
For: A SYSTEM FOR CUSTOMIZING PERSONAL CARE PRODUCTS

Group: 1617
Examiner: S. Wang
Edgewater, New Jersey 07020
August 12, 2004

REPLY BRIEF
Under 37 CFR 1.193

Commissioner for Patents
Alexandria, VA 22313-1450
Sir:

There are enclosed herewith three (3) copies of a Reply Brief for Appellants. The delay in submitting the Instant Brief was unavoidable because applicants never received the Examiner's answer and later noted that the answer was sent May 5, 2004, during a PAIR inquiry on August 3, 2004, by applicant. Further, it was noted during applicant's PAIR inquiry that the Examiner's answer was apparently returned as undelivered mail for unknown reasons. The Instant Reply Brief is now being promptly submitted after careful review of the Examiner's answer, as retrieved from the PAIR system. No fee is believed due in the matter, however, any fee due should be charged to our Deposit Account No. 12-1155. Three copies of this letter are enclosed.

Respectfully submitted,

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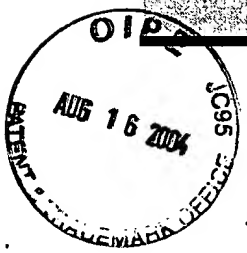

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APPELLANTS' ARGUMENTS

This is in response to the Examiner's Answer mailed May 5, 2004, and actually first received by applicant on August 3, 2004, via PAIR.

With respect to the rejection of claims 1 – 11, 13 – 22, and 25 – 29, under 35 USC 103(a), as being unpatentable over Rath et al. (US 5972322 of record), view of Rigg et al. (US 5622692 of record), and Stewart (WO 98/30189), the Examiner asserts that Rath et al. teaches a method for providing a customized cosmetic product consisting of combined separated components that are selected by the customer, wherein the separated components include a base composition and variable ingredients such as a thickener. Applicants agree with the Examiner's characterization of Rath insofar as the thickener is disclosed as being a component of the variable ingredients that may be added to the customized composition of Rath according to the user's selection. Since the present invention as currently claimed requires that the thickener (thickening composition) be a component of the inventive base composition, which is formulated at a location remote from the location that the customized personal care product is prepared in, Rath by the Examiners own admission fails to disclose or suggest the instant invention. The skilled person would not be motivated to combine Rath's thickener with the product base because Rath expressly teaches that the thickener be added much later in the process to facilitate the thorough blending of the customizable components of Rath's customized cosmetic composition (See column 2, lines 8 – 12). Thus Rath et al. clearly teaches away from the instant invention.

Rigg et al. discloses a method and apparatus for customizing facial foundation products. Stewart teaches a computer controlled device for evaluating consumer test results and preferences (page 16, lines 10 – 20). Both Rigg et al. and Stewart disclose a wide range of additives that may be added to a particular formulation. However, both Rigg et al. and Stewart are silent about how each additive relates to the other, with respect to any ingredients that may be in common with each other. Therefore, neither Stewart nor Rigg et al. disclose or suggest that the vehicle of each additive have at least two ingredients in common, which is required by the instant claims. Absent impermissible hindsight, the skilled person would not combine Rath et al. with Stewart

or Rigg et al., because Rath teaches away from presenting the thickener as a component of the product base which is formulated at a location remote from the location where a customized personal care product is prepared (see instant independent claim 1), and Rigg et al. and Stewart do not remedy the deficiencies of Rath et al. with respect to disclosing or suggesting the instant invention as presently claimed.

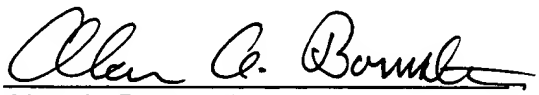
The examiner asserts that the appellant's arguments of whether the thickener should be considered as a variant or base ingredient in the claimed invention and/or if the cited references are irrelevant to the patent ability of the instant application in view of the totality of the cited references. Applicant's respectfully disagree with the Examiners characterizations of the relevance of the thickener because the inventors, being their own lexicographers of their invention, specifically define that thickening agents are a part of the base composition (see page 4, line 30 to page 5, line 10) and as stated in this passage must be added to the base composition at a location that is different than where the performance agents are added (i.e., where the customized product is prepared).

The examiner asserts that the fact that Stewart or Rigg et al., do not teach expressly the variants having at least two ingredients in common as being an obvious limitation to one of ordinary skill in the art. Moreover, the examiner cites Rath et al. (example 16) for the proposition that concentrates may have at least five ingredients in common. Contrary to the examiner's assertion, it is well settled that the examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of the applicant's invention. Rather, the Examiner has the burden to show some teaching or suggestion in the references to support the use in the particular claim combination. (See SmithKlein Diagnostics, Inc., v. Helena Laboratories Corp., 8 USPQ2D 1468 (Fed. Circ.1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new system, does not necessarily render such a system obvious unless the art also contains something to suggest the desirability of the proposed combination, i.e., the motivation to combine the references. In re: Grabiak, 226 USPQ 870,872 (Fed. Cir.1985). The fact that Rath et al. teaches that the

thickener must be applied separately from the base composition would not lead one of ordinary skill to use the opposite configuration and require that the thickener be a part of the base composition. Therefore, there would be no motivation to combine Rath et al. with Rigg et al. and Stewart to derive the instant invention as presently claimed due to the contrary teaching of Rath et al. with respect to how a thickener is introduced into the customized personal care product.

For the above reasons, applicant's respectfully request the Board of Patent Appeals and Interferences to reverse the examiners final rejections under 35 USC § 103(a).

Respectfully submitted,



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